

REMARKS

Claims 1-12, 14 and 16-24 remain in this application. Indication of the allowance/allowability of claims 1-12, 16-21 and 24 is noted and appreciated. Claims 13 and 15 have been cancelled. Claims 14, 16 and 18 have been amended to be presented in independent form. The only difference made to claims 14, 16 and 18 from their original form is adding wherein to the beginning of the fourth paragraph of each of those claims and substituting comprising for “comprises” in the same line of each claim to make that paragraph read more uniformly with the paragraph(s) that follow it in each of these three claims. These amendments do not change the meaning or scope of these claims in any way.

Claim Rejections Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 22 and 23 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Specifically, the Examiner asserts that the term “the one vehicle portion” in claim 22 lacks sufficient antecedent basis. Applicants respectfully traverse these rejections.

Initially, it is noted that, in the past, applicants would not normally traverse such a rejection. However, several recent court decisions hold that any amendment to a claim to avoid a statutory rejection constitutes a surrender of subject matter that denies the applicant/patentee the benefit of the doctrine of equivalents for infringement. Consequently applicants can no longer acquiesce in the face of such rejections, no matter how well meaning or how minor they may be, without losing significant patent rights.

Claim 21, from which claim 22 depends, calls for “at least one motor drivingly coupled with at least one of the road wheels of one of the first and second vehicle portions”. (Emphasis added). While applicants could have called for “the one of the first and second vehicle portions” in claim 22, it is abundantly clear to one of even less than ordinary skill in the art that “the one vehicle portion” phrase is simply shorthand for “the one of the first and second vehicle portions” and is actually less confusing because it reads more naturally. Claim 21 depends from independent claim 20. The above quoted clause in claim 21 is the only place in claim 20 or 21 where “one” is used with respect to a vehicle portion. There is no other language in the claims

20-23 that could give rise to any confusion as to the meaning of the phrase "the one vehicle portion" in claim 22.

Furthermore, the lack of explicit, identical antecedent language does not necessarily render a claim indefinite. See MPEP 2173.05(e) **Lack of Antecedent Basis:**

If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992) ("controlled stream of fluid" provided reasonable antecedent basis for "the controlled fluid").

It is respectfully submitted that the language identified by the Examiner as lacking antecedent basis is at least as clear as the example provided by *Ex parte Porter*, above.

For the foregoing reasons, it is respectfully submitted that claims 22 and 23 are in full compliance with 35 U.S.C. § 112, second paragraph. Accordingly, reconsideration and withdrawal of the rejections to claims 1 through 12 are respectfully requested.

CONCLUSION

In view of the foregoing discussion, it is respectfully submitted that the present application, including claims 1-12, 14 and 16-24 is in condition for allowance. Allowance of the application at an early date is respectfully requested.

Respectfully submitted,

Sean Mullaney et al.

21 Apr. 2004
(Date)

By: 

JOHN JAMIESON

Registration No. 29,546

AKIN GUMP STRAUSS HAUSER & FELD LLP

One Commerce Square

2005 Market Street, Suite 2200

Philadelphia, PA 19103-7013

Telephone: 215-965-1200

Direct Dial: 215-965-1310

Facsimile: 215-965-1210

E-Mail: jjamieson@akingump.com

JJ/vbm